

Appl. No. 09/454,689
Amdt. dated January 2, 2004
Reply to Office Action of November 6, 2003

REMARKS

In the Office Action dated November 6, 2003, claims 1-4, 8, 19-24, 27, 28, 30, 33, 35, 37, 39 and 41 were rejected under 35 U.S.C. § 103 over U.S. Patent No. 6,212,548 (DeSimone) in view of U.S. Patent No. 6,549,937 (Auerbach); claims 5 and 6 were rejected under § 103 over DeSimone and Auerbach in view of U.S. Patent No. 6,430,604 (Ogle); claims 7 and 29 were rejected under § 103 over DeSimone and Auerbach in view of U.S. Patent No. 6,038,602 (Ishikawa); and claims 32, 34, 36, 38, 40, and 42 were rejected under § 103 over DeSimone and Auerbach in view of U.S. Patent No. 5,764,916 (Busey).

The obviousness rejection against claim 1 is a classic example of using impermissible hindsight to pick and choose elements of different references in an attempt to achieve the claimed invention where no motivation or suggestion existed for the proposed combination. The obviousness rejection is defective on two bases: (1) there is simply no motivation or suggestion to combine the cited references in the manner proposed by the Office Action; and (2) even if the references can be combined, the hypothetical combination of references does not teach or suggest the claimed invention.

The second point above is addressed first. *Neither* DeSimone nor Auerbach teaches or suggests either the receiving or processing act of claim 1. The Office Action conceded that DeSimone does not teach a first community associated with a first service provider and a second community associated with a second, different service provider.

The server in the first community associated with a first service provider and the server in the second community associated with a second, different service provider are not isolated elements unrelated to the remaining parts of claim 1. In fact, the server in the first community associated with the first service provider performs the receiving act of claim 1, whereas the server in the second community associated with the second service provider performs the processing act of claim 1. Thus, because DeSimone fails to disclose or suggest servers in first and second communities associated with first and second service providers, DeSimone also fails to disclose or suggest the receiving and processing acts of claim 1.

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Recognizing the deficiency of DeSimone, the Office Action relied upon Auerbach as disclosing first and second communities associated with first and second service providers. However, the Office Action ignored the role of the servers in such communities in the context of claim 1. If the roles of the servers in the first and second communities are considered, as they must, Auerbach also clearly fails to teach or suggest either the receiving or processing acts of claim 1.

As best seen in Figure 2 of Auerbach, Auerbach describes a conversion platform 112 that is provided between a client 102 and a plurality of servers associated with respective service providers (106-110). The client 102 and the conversion platform are part of a system designated 100 (Fig. 2). The conversion platform 112 includes a routing module 128 (Figure 3 of Auerbach) and respective SP protocol service modules 130 and 132, each service module to "[interconvert] between the common format used by the API 126 and a unique protocol required by the service providers SP1 and SP2, respectively." Auerbach, 7:23-28.

This architecture of Auerbach is clearly different from the arrangement recited in claim 1. Note that claim 1 recites receiving a request from a server in a *first community* associated with a first service provider, and processing the request by a server in a *second community* associated with a second, different service provider, to establish a real-time, text-based messaging session. In contrast, in Auerbach, a common conversion platform 112 is used to perform processing of a request from the client 102. The client 102 and conversion platform 112 are part of the same system 100 on which an application program 104 (providing a user interface to the user) resides. Thus, processing of a request to establish a chat session is not performed by a server associated with a given community--the processing is performed by a common conversion platform (residing in the same system as the client 102) that converts between a first format and each of multiple formats that are recognizable by respective different service providers.

Therefore, Applicant respectfully submits that the hypothetical combination of DeSimone and Auerbach does not teach or suggest the claimed invention.

The Office Action criticized Applicant's arguments as "attacking references individually." 11/6/03 Office Action at 13. Applicant disagrees with this assessment. Applicant is merely explaining what each reference teaches. The teachings of the

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references must be considered in their respective contexts to determine whether each reference actually teaches or suggests elements of the claim. The teachings of the references cannot be ignored in an attempt to perform a piecemeal combination of isolated elements, as the Office Action has done. Applicant's arguments are focused on the actual teachings of the references applied in the obviousness rejection. These arguments clearly rebut the piecemeal selection and arbitrary combination of elements, taken wholly out of the context of the teachings of the respective references, in the obviousness rejection asserted in the Office Action. A person of ordinary skill in the art would not pick and choose elements in isolation to combine such elements from multiple references—instead, such a person of ordinary skill would understand the teachings of each reference in their entirety.

A *prima facie* case of obviousness has thus not been established with respect to claim 1 for at least this reason.

There also is no motivation to combine the teachings of DeSimone and Auerbach, as there is no need within the DeSimone system of performing real-time, text-based messaging sessions between terminals associated with different community servers. DeSimone teaches only *one* service processor. Therefore, DeSimone would have no need for the common conversion platform 112 of Auerbach, as DeSimone does not have the incompatibility issues discussed in Auerbach. In view of the foregoing, it is respectfully submitted that no motivation or suggestion exists to combine the teachings of Auerbach and DeSimone.

Therefore, a *prima facie* case of obviousness of claim 1 has not been established for this additional reason.

With respect to independent claim 19, the hypothetical combination of DeSimone and Auerbach does not teach or suggest the recited interface unit and controller. The interface unit of claim 19 (which is in a server associated with a first community) is adapted to receive a contact request over the network from an entity associated with another community, with the entity not being logged onto the server, and the contact request indicating a request to establish a text-based messaging session. Note that each community is associated with a different service provider. The controller of claim 19 is adapted to send a notification to the destination terminal of the contact request and to

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receive an indication from the destination terminal of acceptance of the contact request. Again, claim 19 recites a server of a first community (associated with one service provider) receiving a contact request from an entity associated with another community (associated with another service provider), and a controller to send a notification of the contact request and to receive an indication of acceptance of the contact request. The hypothetical combination of DeSimone and Auerbach does not teach or suggest these elements.

Therefore, a *prima facie* case of obviousness has not been established for at least reason. Also, the obviousness rejection is defective because no motivation or suggestion exists to combine DeSimone and Auerbach, as discussed above.

Similarly, independent claim 20 recites instructions that when executed cause a system in a first community associated with a first service provider to receive a request from a subscriber in a second community associated with a second service provider, and to perform various other acts in response to the request. The processing of a request for a desired text-based messaging session by a system in one community (associated with one service provider) of a request received from another community (associated with another service provider) is not taught or suggested by the hypothetical combination of DeSimone and Auerbach.

Dependent claims are allowable for at least the same reasons as corresponding independent claims.

Moreover, with respect to claim 5 (which depends from claim 1), the asserted combination of DeSimone, Auerbach, and Ogle does not teach or suggest the subject matter recited in claim 5. The teachings of Ogle are inconsistent with the teachings of DeSimone. In DeSimone, the system for enabling chat sessions between users of a chat room require that the names of participants be visible to each other. DeSimone, 5:22-34, 51-54. In chat rooms, users announce their availability to receive messages. DeSimone, 2:8-9. When a user logs onto a server, a notice may be sent to others (such as those on a buddy list). DeSimone, 2:5-8.

Thus, the chat system of DeSimone requires that users be logged on to a server so that users can be visible to each other through chat software. This is inconsistent with the teachings of Ogle regarding alternative actions taken by an instant messaging system

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(IMS) in response to detecting that a user is not logged on to the IMS. Therefore, there is no motivation or suggestion to combine the teachings of DeSimone, Auerbach, and Ogle in the manner proposed by the Office Action.


Similarly, with respect to dependent claim 7, there is no motivation or suggestion to combine DeSimone, Auerbach, and Ishikawa. Again, as discussed above, DeSimone requires that users be logged on to a server to be visible to other users of a chat room. If an IP connection is not even established, as discussed in Ishikawa, then a user of a client that does not have the IP connection would not be visible to other users in the DeSimone chat system. Thus, the teachings of Ishikawa and DeSimone are inconsistent, and as a result, there is no motivation or suggestion to combine DeSimone, Auerbach, and Ishikawa. Therefore, claim 7 is not obvious over the asserted combination of references.

Claim 29 is allowable for similar reasons as claim 7.

In view of the foregoing, each of the pending claims are allowable over the cited references. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (NRT.0010US).

Respectfully submitted,

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